

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket No. 503177.00387

In re Application of Stephen A. Smith, et al.)	
)	
Application No. 10/676,807)	Examiner: Stephen J. Castellano
)	
Filed October 1, 2003)	Art Unit 3781
)	
For: Ergonomic Disposable Cup Having)	Confirmation No. 3085
Improved Structural Integrity)	

APPELLANT'S REPLY BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This constitutes Applicant's Reply Brief on appeal, in response to the Examiner's Answer mailed on September 26, 2007. Thus, this Reply Brief is due by November 26, 2007, and is timely filed. The information specified by 37 C.F.R. § 41.41 and M.P.E.P. 1208 is provided hereunder. Please charge any associated fees to Deposit Account No. 19-0733.

As an initial matter, the Examiner is thanked for the careful analysis that has been given in the Examiner's Answer. Nonetheless, the Examiner's Answer does not provide sufficient reason for maintaining the rejections of the claims of the present application. For the reasons that follow, the Examiner's rejections should be reversed.

I. STATUS OF CLAIMS

Forty-three (43) claims were originally filed in the application, and three (3) were added in prosecution. Claims 1 and 4-14 are pending for appeal. All pending claims have been rejected. A detailed status of the claims is as follows:

- A. Claims originally filed: 1-43
- B. Claims canceled: 2, 3, 32-42
- C. Claims added: 44-46
- D. Claims currently pending: 1, 4-14
- E. Claims allowed: None
- F. Claims rejected: 1, 4-14
- G. Claims objected to: None
- H. Claims withdrawn: 15-31, 43-46
- I. Claims on appeal: 1, 4-14

The only independent claim in this application is Claim 1. Each of the claims involved in this Appeal (Claims 1 and 4-14) are included in the attached Appendix.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed on appeal:

1. Whether Claims 1 and 4-14 were properly rejected for non-statutory, obviousness-type double patenting as being unpatentable over U.S. Design Patent Nos. D514,385, D514,380, D505,830, D504,593, D499,935, D499,934, and D514,884, each individually in view of U.S. Patent No. 3,519,165.

III. ARGUMENTS

A. **Rejection of Claims 1 and 4-14 for Non-statutory Obviousness-type Double Patenting Over U.S. Design Patent Nos. D514,385, D514,380, D505,830, D504,593, D499,935, D499,934 and D514,884 ("Appellants' design patents") in View of U.S. Patent No. 3,519,165 to Hawley ("Hawley")**

In the Final Office Action, the Examiner rejected Claims 1 and 4-14 for non-statutory obviousness-type double patenting as being unpatentable over U.S. Design Patent Nos. D514,385, D514,380, D505,830, D504,593, D499,935, D499,934 and D514,884 ("Appellants' design patents") individually in view of U.S. Patent No. 3,519,165 to Hawley ("Hawley"). Appellants again submit that the Examiner's rejections on these grounds are not proper. More specifically, Appellants submit that (1) the Examiner used an incorrect one-way standard for obviousness determination in rejecting Appellants' claims, and (2) under the correct two-way standard, a double patenting rejection cannot be established.

1. **No Prima Facie Case of Double Patenting Has Been Established Because The Examiner Did Not Use the Proper Two-Way Test for Obviousness**

In the Answer, the Examiner argues that only a one-way determination of obviousness is required to establish obviousness in a utility-design situation. However, the Examiner has not cited a single rule, statute, case, or other precedent that indicates that a one-way determination of obviousness may be sufficient in rejecting utility claims for double patenting over a design patent. Appellant submits that no such law exists, and the two-way standard noted by *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir.1999), and *Carman Indus.*, 724 F.2d 932, 220 U.S.P.Q. 481 (Fed. Cir. 1983), must be used in all double patenting cases where utility claims are rejected over design claims.

The Examiner also argues that the two-way obviousness standard of *Dembiczak* and *Carman Indus.* are case-specific, and that the present facts require using a one-way standard. However, no statement in *Dembiczak* or *Carman Indus.* indicates that the rules established therein are case-specific. Additionally, the guidelines in M.P.E.P. §§ 804 and 1504.06 do not indicate any case-specific exception to the rule. Further, the Examiner offers no explanation of

how the present case is different from *Dembiczak*, or what aspects of the present case require a different standard to be used here.

Accordingly, Appellant submits that a two-way obviousness standard is required to establish a rejection for double patenting for the present claims.

2. Two-Way Obviousness Cannot Be Established With Respect to Claims 1 and 4-14

Appellants submit that if the proper two-way obviousness standard is applied, the rejections of Claims 1 and 4-14 for obviousness-type double-patenting cannot be established, as detailed in Appellants' Brief. Appellants note that in the Answer, as in the Final Office Action, the Examiner did not offer any explanation of how Appellants' design patents were rendered obvious over the claims of the utility patent application, as required under the proper two-way test. In the Answer (P. 6), the Examiner asserted, "It would have been obvious to remove the claimed structure in the drawings of the design references of Smith which is not claimed in the present invention (appellant's present claims) from the design references of Smith as such structure is not necessary." It is not clear whether this represents an attempt by the Examiner to establish obviousness of Appellants' design patents in view of the utility claims. However, even if this does constitute such an attempt, this single statement is not sufficient to establish a *prima facie* case of obviousness. *Dembiczak* is clear that general textual descriptions cannot themselves render obvious a specific design (*Dembiczak*, 175 F.3d at 1002-03), and the Answer does not offer any discussion of specific design characteristics. Thus, no *prima facie* case of two way obviousness has been made, and the double patenting rejections must be withdrawn.

Appellants also submit again that the necessary two-way obviousness determination cannot be properly made, because the general textual descriptions in Appellants' utility claims cannot render the specific designs claimed in Appellants' design patents obvious.

Accordingly, because the required determination of two-way obviousness has not been made, and because such a determination cannot be made, the rejections of claims 1 and 4-14 for obviousness-type double patenting cannot stand.


VIII. CONCLUSION

For the foregoing reasons, and for the reasons given in Appellants' Brief, Appellants respectfully request that the Board reverse the Examiner's rejections of Claims 1 and 4-14 for obviousness-type double patenting, and order that the case be remanded to the Examiner for further prosecution.

Respectfully submitted,

Date: November 26, 2007

By:


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